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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,471	02/07/2002	Charles Eric Hunter	8159.0009-01	3041
23377	7590	10/06/2006	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103				SHANG, ANNAN Q
ART UNIT		PAPER NUMBER		
		2623		

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/072,471	HUNTER ET AL..	
	<b>Examiner</b>	<b>Art Unit</b>	
	Annan Q. Shang	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 June 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                |                                                                   |
|--------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                           | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/16/02</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|                                                                                                                                | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Objections***

1. Claim 22 is objected to because of the following informalities: In claim 22, line 8, the phrase "...periodically, for example monthly, distributing..." should be changed to "...periodically, distributing..." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-15, 18-19 and 21-38 are rejected under 35 U.S.C. 102(e) as being anticipate by **Lowthert et al (2002/0100043)**.

As to claim 1, note the **Lowthert** reference figures 1-5, discloses content with advertisement information segment and further discloses a method of providing a consumer with entertainment content coupled with updated advertisements, comprising:

Recording entertainment content on a first medium (Content Server/Info Server CS/IF 20/30, page 1, [0020-0024]); recording advertisements on a second medium (Ad Server AdS-24, page 1, [0020-0024]); distributing entertainment content pre-recorded on the first medium to customer locations (Receiver R-10); periodically distributing

Art Unit: 2623

advertisements pre-recorded on the second medium to customer locations (page 3, [0041-0044]);

Inserting a first medium (Content Server CS-18) containing customer-selected, pre-recorded entertainment content into a prayer device (R-10, page 1, [0024-0030] and [0049]); inserting a second medium containing pre-recorded advertising content into the player device (R-10, page 1, [0024-0030] and [0049]);

Displaying (Presentation Device PD-14) the selected entertainment content at the customer location via the player device; and displaying advertisements from the second medium at times before, during, or after display of the selected entertainment content and where distributing of items is free of charge to the customer (page 2, [0032-0034] and page 3, [0041-0049]).

As to claims 2-3, Lowthert further disclose where the first medium has a hardware security feature such that display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature and where the first medium and the second medium both have a hardware security feature such that display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature (page 3, [0041-0042]).

As to claim 4, Lowthert further disclose where the first medium and the second medium are the same medium (page 3, [0036] and [0047-0049]).

As to claim 5, Lowthert further disclose where the step of recording on the second medium includes recording both advertisements and an index of entertainment content (page 3, [0038-0040]).

As to claims 6-7, Lowthert further disclose where the advertisements include current movie previews and displaying the movie previews before displaying the selected entertainment content displays selected (page 3, [0036] and [0047-0049]).

As to claims 8-10, Lowthert further where the advertisements include commercial advertisements other than movie previews, wherein the commercial advertisements other than previews are displayed before displaying the selected entertainment content and wherein the entertainment content includes insertion points for display of advertisements, and including the step of displaying advertisements from the second medium at the insertion points (page. 3, [0036] and [0047-0049]).

As to claims 8-10, Lowthert further teaches generating customer preferences by analysis of customer characteristics and selecting a subset of the advertisements contained in the second medium based upon customer preference (page 2, [0035] and [0043-0048]).

As to claims 12-13 Lowthert further discloses where the first medium comprises a disc having a diameter greater than about 125mm and less than 300mm and where the first medium comprises a disc having data recorded on a reflective layer and an optically transmissive coating having a total transmission of 635nm or less than the minimum transmission set forth as the standard DVD specification (page 2, [0021-0025] and ([0048-0049]).

As to claim 14, Lowthert further discloses downloading content from the player device to a second portable player device (page 2, [0021-0025] and ([0048-0049]).

As to claim 15, note the **Lowthert** reference figures 1-5, discloses content with advertisement information segment and further discloses a player device (R-10) for generating audio visual signals representative of entertainment content with advertisements, the device comprising:

Reader mechanism (Controller C-40) reading entertainment content prerecorded on a first medium and reading advertisements pre-recorded on a second medium; and a processor (C-40) generating command signals inserting advertisements read by the reader mechanism from the second medium into entertainment content read by the reader mechanism from the first medium (page 4, [0045-0049]).

As to claims 18 and 19, Lowthert further discloses where the player device comprises a reader mechanism includes a single optical pickup and where the first and second media are mechanically, sequentially moved for reading (page 2, [0035] and [0043-0048]).

As to claim 20, Lowthert further discloses an input (PD-14) for displaying signals from a broadcast content source (e.g., cable TV or direct broadcast satellite) and inserting advertisements prerecorded on the second medium into the broadcast content (page, [0019] and [0043-0049]).

As to claims 22-24, the claimed "A method of providing consumers with entertainment content coupled with updated advertisements..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

As to claim 25, Lowthert further discloses where distributing items to customers is at a charge to customers not exceeding production and shipping costs (page 2, [0034-0036] and [0047-0049]).

As to claims 26-27, Lowthert further discloses where the customers are provided with the entertainment content and updated advertisements without the necessity of the customers having cable TV or direct broadcast satellite service and inputting display signals from a broadcast source (e.g., cable TV or direct broadcast satellite) into the player device and inserting advertisements pre-recorded on the second medium into the broadcast content (page 1, [0020-0025], [0032-0036] and [0042-0047]).

As to claims 28-29, Lowthert further discloses shipping entertainment content on first media to customers on a periodic basis and targeted to customer preferences (page 1, [0020-0025], [0032-0036] and [0042-0047]).

Claims 30-34 is met as previously discussed with respect to claim 1.

As to claim 35, Lowthert further discloses where communicating information that is representative of the playing of entertainment content and advertisements between the customer and system operator (page 2, [0032-0036] and [0042-0047]).

As to claim 35, Lowthert further discloses downloading content from the player device to a second portable player device and where the portable player device includes a projector (page 4, [0048-0049]).

Claim 38 is met as previously discussed with respect to claims 12-13.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lowthert et al (2002/0100043)** as applied to claim 15 above, and in view of **Macrae et al (2004/0103439)**.

As to claims 16-17, Lowthert further discloses a VCR, hard disk, CD-R, CD-RW, DVD-R, etc., but fails to explicitly teach where the reader mechanism comprises a first reader for reading the first medium containing the entertainment content and a second reader for reading the second medium containing the advertisements.

However, note the **Macrae** reference figures 1 and 7, discloses access to Internet data through a TV system and further discloses a plurality of reading mechanism, one for reading time-shifted TV program and the for reading advertisements or Internet data (page 4, [0037-0039], [0044] and [0056-0062]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Macrae into the system of Lowthert to independent control the recording/display TV program or advertisement so that both TV viewing and advertisement may be perform simultaneously.

As to claim 20, Lowthert further discloses a memory device storing read data to permit seamless, uninterrupted insertion of advertisements into entertainment content (page. 3, [0036] and [0047-0049]).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ginter et al (2004/0054630) disclose systems and methods for secure transaction management and electronic rights.

Moore et al (2001/00472298) disclose system and method for metadata-linked advertisements.

Plotnick et al (2005/0097599) disclose alternative ads in prerecorded media.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA) or 571-272-1000**.



Annan Q. Shnag